

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Richard Douglas Kemp  
Application No. : 10/603,207  
Filing Date : 06/25/2003  
Art Unit : 2166  
Confirmation No. : 2681  
Title : ELECTRONIC MANAGEMENT AND DISTRIBUTION OF  
LEGAL INFORMATION  
Attorney : 336001-2024.1  
Docket No.

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

## TABLE OF CONTENTS

	<u>Page</u>
<b>I. Real Party in Interest.....</b>	<b>1</b>
<b>II. Related Appeals and Interferences.....</b>	<b>1</b>
<b>III. Status of Claims.....</b>	<b>1</b>
<b>IV. Status of Amendments.....</b>	<b>1</b>
<b>V. Summary of Claimed Subject Matter.....</b>	<b>1</b>
<b>VI. Grounds of Rejection to Be Reviewed On Appeal.....</b>	<b>4</b>
<b>VII. Argument.....</b>	<b>4</b>
<b>A. The Rejections Under 35 U.S.C. § 102(e) Are Improper Because Lee Fails to Anticipate Any Claim .....</b>	<b>5</b>
1. Claims 1–6, 10–12, 16–24, 56–65, and 68 .....	5
2. Claims 7–9, 66–67 .....	14
3. Claims 30, 32–35, 69 .....	16
<b>VIII. Conclusion .....</b>	<b>18</b>
<b>Claims Appendix.....</b>	<b>19</b>
<b>Evidence Appendix .....</b>	<b>28</b>
<b>Related Proceedings Appendix .....</b>	<b>29</b>

**I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Bloomberg Finance L.P., the assignee of record.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences in connection with this matter.

**III. STATUS OF CLAIMS**

Claims 1–12, 16–24, 30, 32–35, and 56–69 are pending and have been finally rejected. Claims 13–15, 25–29, 31, and 36–55 have been cancelled. The applicant now appeals the rejection of claims 1–12, 16–24, 30, 32–35, and 56–69.

**IV. STATUS OF AMENDMENTS**

An amendment after final rejection was filed on September 19, 2008. By an Advisory Action mailed on September 29, 2008, the examiner indicated that the amendment would be entered.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The application relates to methods and systems for providing information over a communications network (p. 1, lines 17–18). In particular, the application discloses methods and systems for computerized research and monitoring of information about one or more legal and other professional subjects (p. 1, lines 18–20). The information may be related to one or more topics and may be categorized according to type such that, when presented, the information may be tabulated by type (p. 2, lines 7–15).

Thus according to an embodiment of the invention, a user may enter a request for information at a user terminal (p. 18, lines 20–24). One or more computers may receive the

request and, in response, may retrieve responsive information from, *e.g.*, a database (p. 19, lines 27–29). The retrieved information may then be provided for display on a display device associated with the user display (p. 19, line 30–p. 20, line 6). The displayed information may be tabulated by type of information (p. 3, lines 3–12) and may, according to an embodiment of the invention, be selectable such that selection of an item of information causes a request to be made for display on the display device of content associated with the selected item (p. 4, line 30–p. 5, line 7).

Independent claim 1 describes a system for providing legal information comprising associated items of legal information and content (p. 20, lines 7–13). The system comprises at least one computer (Fig. 1, #120) and a plurality of user terminals (Fig. 1, #106) which communicate over a network (p. 11, lines 3–14). The system also comprises at least one database associated with the at least one computer (p. 11, lines 9–14; Fig. 1, #121), which stores the legal information in association with a plurality of legal topics and a plurality of types of legal information (p. 16, lines 18–27), and a computer readable medium or media (p. 32, lines 8–18).

The medium (or media) stores programming that causes the at least one computer to access within the at least one database legal information in association with at least one legal topic responsive to a request received from a user terminal and to cause each item of legal information associated with the accessed information to be provided for display on a display device associated with the user terminal from which the request was received (p. 9, lines 9–16). The presented information is tabulated by type of legal information and configured to be selectable at the user terminal (*id.*; p. 5, lines 14–19). Selection provides a request for display on the display device of the content associated with the selected item (*id.*).

Independent claim 30 describes a method of processing legal information (Figs. 3a, 3b). The method comprises assigning to each of a plurality of documents, each of which comprises legal information relating to a plurality of legal topics, at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information (p. 18, lines 5–12; Fig. 3a, #304.). The method also comprises formatting the documents according to a protocol, storing the formatted documents in at least one database (p. 18, lines 13–16; Fig.

3a, #312), using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics (p. 9, lines 9–15), and causing legal information associated with the identified documents to be provided for display on the display device, tabulated by type (p. 9, lines 15–16).

Independent claim 58 describes a method for providing legal information (Figs. 3a, 3b), which comprises associated items of legal information and content (p. 20, lines 7–13), in a system that comprises at least one computer (Fig. 1, #120), a plurality of user terminals (Fig. 1, #106) which communicate over a network (p. 11, lines 3–14), and at least one database, associated with the at least one computer (p. 11, lines 9–14; Fig. 1, #121), which stores the legal information in association with a plurality of legal topics and a plurality of types of legal information (p. 16, lines 18–27). The method comprises the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal and the at least one computer providing for display, on a display device associated with the user terminal from which the request was received, each item of legal information associated with the accessed information, tabulated by type of legal information (p. 9, lines 9–16). The displayed information is configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item (*id.*; p. 5, lines 14–19).

Independent claim 68 describes a computer program product that comprises a computer program, stored on a computer readable medium (p. 32, lines 14–18), that causes a computer system to perform a method for providing legal information (Figs. 3a, 3b). The legal information comprises associated items of legal information and content (p. 20, lines 7–13), and the computer system comprises at least one computer (Fig. 1, #120), a plurality of user terminals which communicate over a network (Fig. 1, #106), and at least one database, associated with the at least one computer (p. 11, lines 9–14; Fig. 1, #121), storing the legal information in association with a plurality of legal topics and a plurality of types of legal information (p. 11, lines 9–14; Fig. 1, #121). The method comprises the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal and providing for display, on a display device associated with the user terminal from which the request was received, each item of legal information associated with the accessed information (p. 9, lines 9–

15). The displayed information is tabulated by type of legal information (p. 9, lines 15–16) and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item (*id.*; p. 5, lines 14–19).

Independent claim 69 describes a computer program product that comprises a computer program stored on a computer readable medium that causes at least one computer to perform a method of processing legal information (p. 20, lines 7–13; p. 32, lines 14–18). The method comprises assigning to each of a plurality of documents, each of which comprises legal information relating to a plurality of legal topics, at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information (p. 18, lines 5–12; Fig. 3a, #304); formatting the documents according to a protocol (p. 18, lines 9–12; Fig. 3a, #306, 308); storing the formatted documents in at least one database (p. 18, lines 13–16; Fig. 3a, #312); using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics (p. 9, lines 9–15); and causing legal information associated with the identified documents to be provided for display on the display device, tabulated by type (p. 9, lines 15–16).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

In the final Office action dated June 6, 2008 (the “Office Action”), the Examiner rejects claims 1–12, 16–24, 30, 32–35, and 56–69 under 35 U.S.C. § 102(e) as anticipated by U.S. patent no. 6,839,707 to Lee *et al.* Therefore, the issue in this appeal is:

- A. Whether claims 1–12, 16–24, 30, 32–35, and 56–69 are unpatentable under 35 U.S.C. § 102(e) as anticipated by U.S. patent no. 6,839,707 to Lee *et al.*

## **VII. ARGUMENT**

The rejections are not supported by the evidence or the law and are therefore incorrect. The rejections under section 102(e) are necessarily based on interpretation of certain claim terms

contrary to both ordinary usage and the disclosure. And the rejections based on prior art rely solely on a single reference that fails to teach or suggest any of the claimed inventions. Accordingly, the Board must reverse the Examiner's rejections.

**A. The Rejections Under 35 U.S.C. § 102(e) Are Improper Because Lee Fails to Anticipate Any Claim**

This appeal concerns the rejections of all pending claims under 35 U.S.C. § 102(e) as anticipated by U.S. patent no. 6,839,707 to Lee *et al.* Rejection of any claim can stand, however, “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (8th ed. [R-6] 2007) (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). Before rejecting a claim, therefore, the Examiner must interpret that claim and find its elements.

The rules of claim interpretation are long-settled. “The Patent and Trademark Office . . . must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994). The words of the claims themselves define the scope of the patented invention. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). And although the Patent and Trademark Office must give these words their broadest reasonable interpretation, that interpretation must be consistent with the one that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999).

The interpretation must also be consistent with the specification. MPEP § 2111 (8th ed. [R-6] 2007) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 U.S.P.Q.2d 1827, 1830 (Fed. Cir. 2004)). The applicant is entitled to be his own lexicographer. MPEP § 2111.01(IV) (8th ed. [R-6] 2007). Moreover,

The specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the meaning of a claim term when applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in the context in the specification.”

*Id.* (citing *Phillips v. AWH Corp.*, 415 F.3d 1303 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005) (*en banc*) and *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 U.S.P.Q.2d 1573, 1577 (Fed. Cir. 1996)).

Applying these principles, the rejections must be overturned. The examiner has interpreted claim limitations contrary to the plain meaning of the words and to the specification. And, as shown below, Lee neither teaches nor suggests these limitations, when they are properly interpreted, or others of the pending claims.

*1. Claims 1–6, 10–12, 16–24, 56–65, and 68*

The application discloses systems and methods for the computerized research and monitoring of information related to legal and other professional topics. (§ 0003.) When information is acquired, that information may be associated with one or more topics and then classified according to type or class within the topic. (§ 0041.) For example, within the legal field, topics may include “securities law” and “contracts law,” among many others. Types, in turn, are distinct from topics and may include, for example, “administrative action,” “current rulemaking,” “news,” “recent cases,” and “legislative alerts,” among many others. (*Id.*) Association with a topic, classification, or both, may involve associating one or more identifiers with the information, *e.g.*, by physically marking a printed document that contains the information or storing the information electronically in association with other, identifying information. (§ 0041.)

A user, according to the application, may request information by topic. Information responsive to the request may be classified by type. (§ 0024.) When presented to the user, the responsive information may then be sorted by both topic and type. (*Id.*)

According to the specification, “items of legal information,” “legal topics,” and “types of legal information” are mutually exclusive categories. Information may be classified separately under one or more topics and one or more types. (§ 0042.) Types may be the same across all topics (unlike, *e.g.*, subtopics, which may be expected to vary radically between legal topics). (*Id.*) Thus, an item of legal information may be associated with a legal topic, a type of legal



information, or both, but it cannot *be* either of those things. A topic may not be a type, and a type may not be a topic.

Claim 1, for example, reflects the significance of both topics and types:

1. A system for providing legal information comprising associated items of legal information and content, the system comprising:

at least one computer and a plurality of user terminals which communicate over a network;

at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information; and

a computer readable medium or media storing programming that causes the at least one computer to:

access within the at least one database legal information in association with at least one legal topic responsive to a request received from a user terminal; and

cause each item of legal information associated with the accessed information to be provided for display on a display device associated with the user terminal from which the request was received, tabulated by type of legal information and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item.

In the Office Action, the examiner asserts that Lee anticipates this claim. (Office Action at 3.) The assertion is incorrect, however, and the rejection must be reversed, at least because Lee fails to teach or suggest, among other things: (a) at least one database storing legal information in association with a plurality of legal topics, a plurality of types of legal information, or both, and (b) a computer readable medium storing programming that causes at least one computer to cause items of legal information to be provided for display on a display device, tabulated by type of legal information, as set forth in claim 1.

a) *Lee Fails to Teach or Suggest at Least One Database Storing Legal Information in Association With a Plurality of Legal Topics and a Plurality of Types of Legal Information*

Lee fails to teach or suggest a database storing legal information in association with a plurality of legal topics, as claim 1 requires, not least because Lee fails to teach or suggest the existence of a plurality of legal topics.

Lee discusses a system, described as a “Legal Management System” (LMS), for managing information within an organization. (Col 1, lines 32–46.) The LMS, according to Lee, captures information within an organization, e.g., by spidering the organization’s document repositories, and makes the captured information available to users. (Col. 7, lines 5–10.) The LMS also serves as a Web-based tool for communicating within the organization. (Col. 1, lines 32–33.) The goal, according to Lee, is to provide an integrated system for managing knowledge within the organization. (Col. 5, lines 50–53.)

Lee makes clear, however, that the organization of knowledge in the LMS does not reflect any classification based on legal topics. Instead, the organization of captured knowledge reflects the organization of the business. (See, e.g., col. 5, lines 37–49.) This organization of knowledge naturally flows from the nature and purpose of the LMS, according to Lee: The goal of the LMS is to manage information about a business that uses the LMS, not information about the law. (Col. 1, lines 50–53.)

Fig. 6 illustrates how the LMS organizes information, according to Lee. The displayed information is listed under various top-level headings, which are also referred to as “logical groups.” (Col. 7, line 66–col. 8, line 35.) The choice of reflect the needs of the business, not any scheme of legal classification. For example, the top-level logical groups depicted in Fig. 6 of Lee include “Practice Groups,” “Regional Components,” “Our Organization,” “Technology,” “Human Resources,” “Legal Productivity,” and “Quality.” The foregoing is manifestly not a list of legal topics.

As Lee depicts, the top-level logical groups are further subdivided, again reflecting the needs and structure of the organization that uses the LMS. The “Regional Components” logical group, for example, is subdivided into different geographic areas, such as Asia, Canada, Mexico,

among others. (Fig. 6.) Fig. 8 of Lee further depicts subfolders within the Mexico regional component, which reflect the organization of the business entity's operations in that country. For example, under the heading "Communications," Fig. 8 has a link to information about the attorney responsible for the business entity's Mexican affairs and another link to a listing of local outside counsel. Under heading "Commercial Transactions," items include a link to a "Global Sales Rep Database." Again, these subdivisions reflect the organization and operations of a Mexican "regional component," according to Lee, not any ordering of topics in Mexican law. (Col. 8, lines 49–63.)

In response to the applicant's showing that Lee fails to teach or suggest the existence of legal topics, the examiner cites the list of practice groups in Fig. 6 of Lee. (Office Action at 17.) But it is well known that a practice group is typically a group of people who commonly work together within a larger legal practice. And such a group is not a legal topic, even though the name of a practice group may be the same as the name of a legal topic.

The difference is not merely semantic. A heading that gives the name of a legal topic may, in a particular case, be expected to lead to information related to that legal topic, to the exclusion of information relevant to other topics. A legal practice group, in contrast, may collect information according to many topics, including multiple legal topics other than one having a name that is the same as, or similar to, the name of the practice group. It is well known, for example, that an intellectual property practice group may hold and organize information related to legal topics in addition to intellectual property, such as, *e.g.*, antitrust law and practice under the U.S. Hatch-Waxman Act, among others. Indeed, information categorized under a practice group may not relate to any topic related to law at all, including, for example, the group's procedures for ordering office supplies, or the plans for a summer picnic involving the group.

Figs. 10 and 11 of Lee illustrate exactly this distinction. The user interface screen depicted in Fig. 10 is used to manage the organization of information related to multiple practice groups. Upon selection of a practice group in Fig. 10 of Lee, the user is shown the screen depicted in Fig. 11, which is used to manage the organization of information associated with that practice group. (Col. 9, lines 44–47.) The subfolders reflect the internal structure and operations of the practice group, including headings such as "Best Practices" and "Communications." (Col.

9, lines 47–52.) Manifestly, none of the headings relates to any legal subtopics, contrary to what one might expect to find if the heading were the name of a legal topic, not a practice group.

Additionally, Lee fails to teach or suggest a database storing information in association with a plurality of types of legal information, as claim 1 requires, not least because Lee fails to teach or suggest the existence of a plurality of types of legal information.

A “type of legal information” within the meaning of claim 1 is not merely any classification of information. Indeed, the specification makes clear that a “class” of information is much broader than a “type.” The term “type of legal information” is consistently used in the application only to refer to classifications that relate to the legal import or authority of the legal information. (¶¶ 0008, 0015, 0021, and 0042.) The patent claims that explicitly recite types for inclusion in the plurality of types of legal information also consistently follow this usage. (See pending claims 2, 4, and 5.)

Conversely, the context shows that any reference to “types” or other classifications that is not so limited is not referring to types of *legal information* within the meaning of claim 1. For example, paragraph 0042 of the application refers to processing that depends upon the type of *document*, not the type of legal information that the document includes. And as described in paragraph 0044, normalization may include classifications including identifying information common to “all types of documents.” (Also, the classification described in paragraph 0044 is part of normalizing the document and distinct from the association of the document with one or more types of legal information, which is described in paragraphs 0041 and 0042.)

Lee contains no discussion of types of legal information, as that term is used in the present application. Although Lee does mention file types in one place (col. 9, lines 6–8), the context makes clear that Lee is discussing only types of computer files, not types of legal information. The discussion involves only the format in which data is represented, and Fig. 9 of Lee depicts a user interface screen that includes containers for holding data in such file formats. There is no suggestion of any classification of the information that the file represents, much less of the existence of types of legal information within the meaning of claim 1.

Moreover, claim 1 requires more than the storage of information that relates to a plurality of legal topics or one or more classifications. According to claim 1, legal information must be stored in at least one database in association with a plurality of legal topics and also in association with a plurality of types of legal information.

Lee, in contrast to claim 1, discusses storing information only in association with groups within a larger business, and fails to teach or suggest at least one database storing information in association with a plurality of legal topics and a plurality of types of legal information, as claim 1 requires. In Fig. 3, for example, Lee depicts only information stored, in a database, in a way that reflects the organization of the business entity. (Col. 5, lines 37–49.) Nothing in Fig. 3, or anywhere else in Lee, depicts, teaches, or suggests storing legal information in association with a plurality of legal topics and also in association with a plurality of types of legal information, as claim 1 requires.

In connection with this limitation, the examiner also cites Lee at columns 1 and 2. (Office Action at 3.) But the cited portion discusses only storing “business/legal information” that is relevant to a business entity. (Col. 1, line 60–col. 2, line 6.) Lee does mention storing data in different sections of a single, centralized database, but the sections of the database reflect only the organization of the business entity. (Col. 4, line 66–col. 5, line 49.) And, as discussed above, the sections of the database may correspond to the top-level logical groups, but these fail to correspond to any legal topics or types of legal information within the meaning of claim 1.

Nor does Lee teach or suggest at least one database storing items of information in association with a plurality of legal topics, as in claim 1, for the additional reason that Lee fails to teach or suggest how such association could be created or maintained. Lee discusses indexing of documents following automated analysis (col. 7, lines 5–10) and further discusses users uploading documents to the system (col. 10, lines 9–22). But manually uploaded documents are organized only according to the folder that the user puts them in (col. 10, lines 9–22), and Lee says nothing about how spidering or other document acquisition contributes to the ordering of automatically-indexed information. Lee therefore fails to teach or suggest any manual or automatic function or process that could lead to an item of legal information being stored in association with one or more topics.

For at least the foregoing reasons, Lee fails to teach or suggest this limitation of claim 1. The examiner's rejection of claim 1 as anticipated by Lee is therefore erroneous and ought to be reversed by the Board.

b) *Lee Fails to Teach or Suggest a Computer Readable Medium Storing Programming Causing Items of Legal Information to Be Provided for Display, Tabulated by Type of Legal Information*

As shown above, Lee fails to teach or suggest even the mere existence of types of legal information. Consequently, Lee must fail to teach or suggest a computer readable medium storing programming causing items of legal information to be provided for display, tabulated by type of legal information, as claim 1 requires.

In the Office Action, however, the examiner cites several portions of Lee that, in the examiner's view, teach this limitation of claim 1. The examiner asserts on page 15 of the Office Action, for example, that the grouping of several items of information under the heading "Practice Groups" is such a tabulation. "Practice Group," in the examiner's view, is the type of legal information, and the names of the practice groups are items of legal information.

What is not clear, however, is just how the heading "Practice Groups" can be considered a "type of legal information" within the meaning of claim 1. In ordinary usage, a practice group is not a type of legal information: the term "practice group" may typically refer to a group of people who commonly work together within a larger legal practice. The examiner's usage is also entirely inconsistent with the specification, as discussed above. Nor are the names of individual practice groups "items of legal information," as that term is used in the application; they designate groups of people within a larger organization.

In connection with this limitation, the examiner also cites Lee at columns 7 and 8 and the accompanying Figs. 6 and 7. (Office Action at 3.) In columns 7 and 8, Lee discusses organizing headings by top-level logical groups and then by practice groups. But, as shown above, neither the logical groups nor the practice groups of Lee are "types of legal information" within the meaning of claim 1.

Fig. 6 of Lee, discussed previously, depicts a home page of an LMS according to Lee. The examiner asserts that the names of the practice groups (reference numbers 340, 350, 380, etc.) are the items of legal information, and the various headings (reference numbers 270, 274, 278, etc.) are the types under which the items are tabulated. (Office Action at 14.) Neither part of this assertion is viable.

As a threshold matter, the examiner's assertions are mutually inconsistent. As shown above, according to the specification and the claims, the items of legal information, the legal topics, and the types of legal information are all mutually exclusive. An item of legal information cannot be a legal topic or a type of legal information, and a legal topic cannot be a type of legal information. The examiner ignores these constraints, however, asserting in one place that the names of the practice groups in Fig. 6 are a plurality of legal topics (Office Action at 17), but asserting in another that these same names in the same figure are the items of legal information (Office Action at 15). The examiner is mistaken: nothing, including the names of the practice groups, can be both the legal topics and the items of legal information of claim 1.

And in fact, the names of the practice groups in Lee are *neither* the legal topics nor the items of legal information. As already shown, the names of practice groups are not legal topics. Nor can they be types of legal information: types of legal information, as used in claim 1, are certain kinds of categories, as shown above, but these names in Lee are the names of practice groups within the business entity. Nor are the items under the other headings items of legal information. Some of these items are the names of other units within the business entity, and others refer to the subject matter of communications and notices having to do with the operations of the business entity.

Similarly, to treat the headings in Fig. 6 of Lee as types of legal information, as the examiner does (Office Action at 15–16), is inconsistent with both the ordinary use of the term and the way that term is used in the applicant's specification and claims. For example, the heading “Human Resources” of Fig. 6 cannot reasonably be considered a type of legal information when the items gathered under it include, *e.g.*, “Executive Recruiters” and “People on the Move.” To the contrary, as shown above, the headings are simply the top-level folders

within a knowledge-management system, and they correspond to the organization of the business entity, not to types of legal information as in claim 1.

Fig. 7 of Lee, also cited by the examiner in connection with tabulation by types of legal information (Office Action at 3), fails to support the rejections. Fig. 7, according to Lee, depicts an example page of the LMS, dedicated to the intellectual property practice group. (Col. 8, lines 36–48.) The depicted items comprise various headings and subheadings, and, as with Fig. 6, the organization of these items reflects the organization and activities of the practice group. The depicted headings of Fig. 7 are “Quality Initiatives,” “Practice Areas,” “Communications,” “Preferred Providers,” “Document Library,” and “Links.” It should be apparent that none of these names a type of legal information, neither within the ordinary usage of the term, nor as the term is used in the present application.

For at least the foregoing reasons, Lee fails to teach or suggest this limitation of claim 1. The examiner’s rejection of claim 1 as anticipated by Lee is therefore erroneous and ought to be reversed by the Board.

Independent claims 58 and 68 include limitations that correspond to the limitations of independent claim 1, discussed above, and it is submitted that these claims are allowable for the reasons discussed above. Claims 2–6, 10–12, 16–24, 56–57, and 59–65 depend directly or indirectly on one of claim 1 and claim 58, and it is submitted that these claims are therefore allowable based on their inclusion of allowable subject matter. The Board is therefore respectfully asked to reverse the rejections of these claims as well.

## *2. Claims 7–9, 66–67*

Claims 7–9 and 66–67 depend directly or indirectly on claim 1, which has been shown above to be allowable. The claims are therefore allowable based on their inclusion of allowable subject matter, and the examiner’s rejections of these claims ought to be reversed.

But the rejections of these claims are incorrect for additional reasons. Claim 7, for example, reads:



7. The system of claim 1, wherein the programming causes the at least one computer to:

automatically access within the at least one database new legal information responsive to the request while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and

provide for display on the display device each item of legal information associated with the accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type.

Contrary to the examiner's assertion, Lee neither teaches nor suggests programming that causes a computer to automatically access within any databases new legal information responsive to a request while items of legal information associated with previously accessed legal information is provided for display on a display device, or providing for display legal information associated with any such new legal information, as set forth in claim 7. Indeed, Lee fails to discuss or suggest any sort of automatic updating that might take place while any information is displayed.

In connection with this limitation, the examiner cites Lee at column 2, lines 7–22 and Fig. 6. (Office Action at 5.) Neither cited portion teaches or suggests any limitation of claim 7, however, and the rejection of these claims must therefore be reversed.

The first cited portion of Lee is lines 7–22 of column 2. This portion discusses a method within Lee of receiving, storing, and managing “legal/business information.” (Col. 2, lines 7–14.) Within this portion, Lee does mention that a centralized database may periodically be updated. (Col. 2, lines 14–22.) But nothing in this text or the surrounding context teaches or suggests automatically searching within such a database for new information responsive to a request while previously accessed information is provided for display, as claim 7 requires. Nor does it teach or suggest providing any information associated with any new information so found for display along with previously accessed information, as claim 7 also requires.

The second cited portion of Lee is Fig. 6. Fig. 6 depicts an exemplary main page user interface of an LMS according to Lee. (Col. 3, lines 1–2.) The figure depicts a Web page displayed in a Web browser. (Fig. 6.) It is respectfully submitted that nothing about this figure suggests any sort of automatic searching or updating.

For these reasons, the examiner's rejection of claim 7 is erroneous and must be reversed. Claims 8–9 and 66–67 include limitations similar to those discussed above in connection with claim 7, and it is therefore submitted that these claims are allowable for the same reasons that claim 7 is. The Board is therefore respectfully asked to reverse the rejections of these claims as well.

3. *Claims 30, 32–35, 69*

Claim 30 reads:

30. A method of processing legal information, the method comprising:

assigning to each of a plurality of documents which each comprises legal information relating to a plurality of legal topics at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information;

formatting the documents according to a protocol;

storing the formatted documents in at least one database;

using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics; and

causing legal information associated with the identified documents to be provided for display on the display device, tabulated by type.

As discussed in connection with claim 1, above, Lee neither teaches nor suggests several limitations of the above claim. These limitations include assigning to each of a plurality of

documents at least one identifier associated with one of a plurality of legal topics and at least one identifier associated with one of a plurality of types of legal information, as set forth in claim 30. These limitations also include causing legal information to be provided for display, tabulated by type, as set forth in claim 30. For these reasons, the examiner's rejection of claim 30 was in error and should be reversed.

Additionally, however, Lee neither teaches nor suggests formatting documents according to a protocol and storing the formatted documents in at least one database, as also set forth in claim 30. The specification discusses formatting documents according to a protocol as affecting the arrangement of data within a file. For example, at paragraph 0051 of the application, the protocol is discussed as something that specifies the order and content of substantive data within a file. This paragraph reads, in part: "The protocol can establish, for example, the format of the document data file or data set content (e.g., machine-readable header followed by image, hypertext, or program-specific data) and format and order of any headers associated with the document." Persons skilled in the relevant arts will recognize that this is not the same as specifying a file type (e.g., PDF, Microsoft Word® document, etc.), as the items listed in the quoted portion of the application may be ordered differently in different documents of the same file type, and may even be omitted in some documents of a particular type while included in others.

In this connection, the examiner cites only Lee at column 9, lines 3–65. (Office Action at 9.) But the only mention in the cited portion of Lee of anything even related to data formats is this: "Folders are containers for organizing files of various types such as Microsoft Word, Excel, Power point, HTML, etc." (Col. 9, lines 6–8.) The remainder of the cited portion discusses only management of folders and certain examples of how folders are organized. Nothing in Lee, in the cited portion or anywhere else, discloses or suggests formatting documents according to a protocol, as set forth in claim 30.

It is therefore submitted that claim 30 is allowable over Lee, and the examiner's rejection of this claim is erroneous and should be reversed. Claim 69 includes limitations similar to those of claim 30 discussed above, and it is therefore submitted that the examiner's rejection of this claim was erroneous for the same reasons as discussed in connection with claim 30. Claims 32–

35 depend directly or indirectly upon claim 30, and it is therefore submitted that these claims are allowable, at least for their inclusion of allowable subject matter. The Board is therefore respectfully asked to reverse the rejections of these claims.

## **VIII. CONCLUSION**

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance, and the Board is respectfully requested to overturn the Examiner's rejection of these claims.

Date: December 17, 2008  
Customer No. 20999  
Frommer Lawrence & Haug LLP  
745 Fifth Avenue  
New York, NY 10151  
Tel. (212) 588-0800  
Fax (212) 588-0500

Respectfully submitted,

                    /Jon E. Gordon/                      
Jon E. Gordon  
Reg. No. 55,217  
Attorney for Applicant

## CLAIMS APPENDIX

This appeal relates to the following claims:

1. A system for providing legal information comprising associated items of legal information and content, the system comprising:
  - at least one computer and a plurality of user terminals which communicate over a network;
  - at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information; and
  - a computer readable medium or media storing programming that causes the at least one computer to:
    - access within the at least one database legal information in association with at least one legal topic responsive to a request received from a user terminal; and
    - cause each item of legal information associated with the accessed information to be provided for display on a display device associated with the user terminal from which the request was received, tabulated by type of legal information and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item.
2. The system of claim 1, wherein the plurality of types of legal information comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions, and news.
3. The system of claim 1, wherein causing each item of legal information to be provided for display comprises causing each item of legal information to be provided for display in a separate display window by type.

4. The system of claim 3, wherein the plurality of types of legal information comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials.
5. The system of claim 3, wherein the plurality of types of legal information comprises at least: administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials.
6. The system of claim 1, wherein the plurality of legal topics comprises at least two of: admiralty and maritime; alternative dispute resolution; antitrust; trade regulation; banking; finance; bankruptcy; business; commercial; consumer rights; corporate; business organizations; civil rights; collectibles and personal property; communications; media; constitutional; construction; contracts; criminal; education; employment; labor; entertainment; gaming; sports; environmental; estates, trusts, and wills; family; government; elections and politics; government benefits; government contracts; government administration; state government; local government; health; human rights; immigration; insurance; intellectual property; copyrights; patents; trademarks; international; international trade; internet; litigation; litigation administration; appellate procedure; civil procedure; damages and remedies; evidence; mergers and acquisitions; military; natural resources; energy; native populations; professions and occupations; professional licensing; professional responsibility; products liability; real property; science and technology; securities; US federal taxation; state taxation; international taxation; torts; transportation; and workers' rights.
7. The system of claim 1, wherein the programming causes the at least one computer to: automatically access within the at least one database new legal information responsive to the request while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and provide for display on the display device each item of legal information associated with the accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type.

8. The system of claim 1, wherein the programming causes the at least one computer to:  
automatically and periodically access the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and  
if new legal information responsive to the request is stored within the at least one database, provide for display on the display device each item of legal information associated with the new legal information, together with each item of legal information associated with the previously accessed legal information all tabulated by type.
9. The system of claim 1, wherein the programming causes the at least one computer to:  
automatically and continually access the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and  
if new legal information responsive to the request is stored within the at least one database, provide for display on the display device each item of legal information associated with the new legal information, together with each item of legal information associated with the previously accessed legal information all tabulated by type.
10. The system of claim 1, comprising a plurality of databases for storing the legal information, wherein the legal information is stored in separate databases by legal topic.
11. The system of claim 1, comprising a plurality of databases for storing the legal information, wherein the legal information is stored in separate databases by type of legal information.

12. The system of claim 1, comprising a plurality of databases for storing the legal information, wherein the legal information is provided by a plurality of sources, and the legal information is stored in separate databases according to the source that provided the information.

13–15. (canceled)

16. The system of claim 1, wherein the programming causes the at least one computer to display on the display device tabulated by type each item of legal information provided for display.

17. The system of claim 16, wherein each item of legal information displayed on the display device is associated with a selectable link to the associated content, and wherein the programming causes the at least one computer to generate a request to retrieve the associated content from the at least one database in response to selection of a selectable link at the user terminal.

18. The system of claim 57, wherein the displayed content comprises a complete version of a document.

19. The system of claim 57, wherein the displayed content comprises an abbreviated version of a document.

20. The system of claim 19, wherein the abbreviated version of a document comprises a summary of a document.

21. The system of claim 19, wherein the abbreviated version of a document comprises at least one redacted portion of a document.

22. The system of claim 57, wherein the displayed content comprises at least a partial image of a document.

23. The system of claim 57, wherein displayed content and a displayed item of information with which the displayed content is associated are displayed in different display windows.



24. The system of claim 57, wherein displayed content and a displayed item of information with which the displayed content is associated are displayed in different monitor screens.

25–29. (canceled)

30. A method of processing legal information, the method comprising:  
assigning to each of a plurality of documents which each comprises legal information relating to a plurality of legal topics at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information;  
formatting the documents according to a protocol;  
storing the formatted documents in at least one database;  
using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics; and  
causing legal information associated with the identified documents to be provided for display on the display device, tabulated by type.

31. (canceled)

32. The method of claim 30, wherein documents are stored in a plurality of databases.

33. The method of claim 32, wherein the documents are stored in the plurality of databases according to at least one of: the topics in relation to which the respective documents are stored, the types assigned to the documents, and a source of the documents.

34. The method of claim 30, comprising:  
checking formatted documents for compliance with a document receiving protocol; and  
generating a notice of defects automatically upon determination that a checked document does not comply with the protocol.

35. The method of claim 34, comprising automatically performing the assigning and formatting steps on the non-complying document.

36–55. (canceled)

56. The system of claim 16 wherein the programming stored on the computer readable medium or media causes the at least one computer to provide for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal.

57. The system of claim 56 wherein the programming stored on the computer readable medium or media causes the at least one computer to display on the display device the content provided for display.

58. A method for providing legal information comprising associated items of legal information and content in a system comprising at least one computer and a plurality of user terminals which communicate over a network, and at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information, the method comprising:

the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal; and  
the at least one computer providing for display on a display device associated with the user terminal from which the request was received each item of legal information associated with the accessed information, tabulated by type of legal information and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item.

59. The method of claim 58, comprising the at least one computer displaying on the display device tabulated by type each item of legal information provided for display.

60. The method of claim 59, comprising the at least one computer providing for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal.

61. The method of claim 60, comprising the at least one computer displaying on the display device the content provided for display.
62. The method of claim 59, wherein displaying each item of legal information comprises displaying each item of legal information in a separate display window by type.
63. The method of claim 61, wherein displaying the content comprises displaying the content in a different display window than each associated displayed item.
64. The method of claim 61, wherein displaying the content comprises displaying the content in a different monitor screen than each associated displayed item.
65. The method of claim 59, wherein each item of legal information displayed on the display device is associated with a selectable link to the associated content, the method comprising generating a request to retrieve the associated content by selection of a selectable link at the user terminal.
66. The method of claim 58, comprising the at least one computer:  
automatically accessing within the at least one database new legal information responsive to the request while providing for display each item of legal information associated with the previously accessed legal information; and  
providing for display on the display device each item of legal information associated with the accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type.
67. The method of claim 60, comprising the at least one computer:  
automatically and periodically accessing the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and

if new legal information responsive to the request is stored within the at least one database, providing for display on the display device each item of legal information associated with the new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type.

68. A computer program product, comprising a computer program stored on a computer readable medium that causes a computer system to perform a method for providing legal information comprising associated items of legal information and content, the computer system comprising at least one computer and a plurality of user terminals which communicate over a network, and at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information, the method comprising:

the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal; and  
the at least one computer providing for display on a display device associated with the user terminal from which the request was received each item of legal information associated with the accessed information, tabulated by type of legal information and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item.

69. A computer program product, comprising a computer program stored on a computer readable medium that causes at least one computer to perform a method of processing legal information, the method comprising:

assigning to each of a plurality of documents which each comprises legal information relating to a plurality of legal topics, at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information;  
formatting the documents according to a protocol;  
storing the formatted documents in at least one database;

using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics; and causing legal information associated with the identified documents to be provided for display on the display device, tabulated by type.

## **EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.